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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,638	11/14/2000	Isidore Rigoutsos	YOR920000435US1	8850

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EXAMINER

LY, CHEYNE D

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

Advisory Action

Application No.

09/712,638

Applicant(s)

RIGOUTSOS ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-12, 23, and 25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Applicant's Interview Summary, February 10, 2004, has been acknowledged.

The amendment by cancellation of claims 13-22, 24, and 26 has been acknowledged. Therefore, claims amendment via the cancellation of claims 13-22, 24, and 26 has been entered.

Continuation of 3. Applicant's reply has overcome the following rejection(s): Claim 4, 35 USC §112, First Paragraph, Lack of Written Description and Lack of Enablement rejections.

Continuation of 5. does NOT place the application in condition for allowance because: Claims 1-12 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained with respect to claim 1-12 and 25, as recited in the previous office action mailed March 26, 2003.

Applicant's argument via pointed to support for the phrase "candidate sequence" (page 6, lines 5-7; page 8, line 11; and page 9, lines 14-18), and "patterns" (page 6, lines 12-15; page 8, lines 12-14; page 9, line 3-5), wherein one of ordinary skill in the art would be able to determine the either a "candidate sequence" or "patterns" consistent with the scope of the claimed invention, has been fully considered and found to be unpersuasive.

Specific to the phrase "candidate sequence", the pointed to citation further supports the vague and indefinite issue because it is unclear whether said "candidate sequence" is a member of a family which requires sequence information to be known, or "the exemplar sequence wherein no information is known."

Specific to "patterns", the pointed to support does not help Applicant resolve the vague and indefinite issue. Pages 6, 8, and 9 further support the vague and indefinite issue because it is unclear whether "patterns" refer to a specific sequence of symbols or information directed to the expression of said sequences that resulted in distinct patterns corresponding to said sequences. It is well known in the art that sequences of nucleic acid molecules has been widely used for discovering patterns of expression. One of ordinary skill in the art would not know whether "patterns" is directed to specific string sequences or information directed to a particular nucleic acid sequence such as expression of said sequences that resulted in distinct patterns corresponding to said sequences.

Claims 1-8, 10-12, 23 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Benson et al. (1997). This rejection is maintained with respect to claim 1-8, 10-12, 23 and 25, as recited in the previous office action mailed March 26, 2003.

Applicant's argument that Benson et al. does not teach the limitation of "discovering patterns or determining if a candidate sequence comprises the patterns" has been fully considered and found to be unpersuasive as discussed below.

Specific to the argument that cited disclosure of clustering EST data as directed to the UniGene Collection does not anticipate the limitation of "discovering patterns." The instant specification does not provide a specific definition for the critical limitation "patterns"; therefore, in one embodiment, the term "patterns" could easily be construed to mean a set of specific sequence of symbols (page 8, lines 11-26). Therefore, the citation "[u]nigene starts with human entries in the primate (PRI) division of GenBank, combines these with human ESTs and creates clusters of sequences that share virtually identical 3' untranslated regions" (patterns) (Page 2, column 2, lines 53-57) is consistent with the critical limitation of "patterns" as loosely defined by the instant specification.

Specific to Applicant's argument that Benson et al. does not disclose the critical limitation of determining whether a candidate sequence comprises certain patterns, ESTs (set of sequence patterns) provides the major source of new gene discoveries (candidate sequence) via BLAST searches against the dbEST (discovering patterns) (page 2, EST Data §). Further, it is well known in the art that BLAST sequence similarity searching has been widely used for discovering similar sequences (patterns) (page 5, column 1, BLAST Sequence Similarity Searching §).


ARDIN H. MARSCHEL 3/16/04
PRIMARY EXAMINER